

REMARKS

In a Final Office Action dated August 25, 2004, the Examiner rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Sievers et al (U.S. Patent No. 3,893,775) in view of Kurashiki (JP 06171012). Applicants submitted a Response to the Final Office Action, dated November 12, 2004. Subsequently, the Examiner issued an Advisory Action, dated December 9, 2004, declining to enter the proposed amendments as requiring further consideration and/or search and as raising the issue of new matter. Remarks directed to the Examiner's rejections are provided below.

Claims 8 and 9 are currently pending in the application. Claims 12-19 were subjected to restriction requirement and are currently withdrawn from consideration; claims 1-7, 10 and 11 had previously been canceled.

Claims 8 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sievers et al. in view of Kurashiki. Amended claim 8 recites a damper having a hub, an inertia mass body, a polymer elastic body and an organosilane as a non-slip agent, wherein the surface roughness in at least one of a metal surface adhering to the polymer elastic body in the hub and a metal surface adhering to the polymer elastic body in the inertia mass body is within a range of 15 to 50 μmRz .

Applicants have amended claim 8 to recite a surface roughness of 15 to 50 μmRz . This amendment is supported by FIG. 4; page 15, lines 12-17; Table 4 on page 17; the paragraph bridging pages 17-18; page 18, lines 21-23; and the original claims. In In re Wertheim, 541 F.2d 258, 191 USPQ 90 (CCPA 1976), the ranges described in the original specification included a range of 25% to 60% for the concentration of solid matter in coffee extract. The court found that a new claim limitation of a range "between 35% and 60%" did meet the description requirement. The court noted that the PTO had not presented any evidence that there was any distinction, in terms of the operability of the disclosed process or of the achieving of any desired result, between the claimed lower limit and that disclosed in the original specification. Id. at 264. The situation in the present application is analogous to the situation

addressed by the court in In re Wertheim. Thus, Applicants respectfully submit that no new matter has been added.

The Sievers reference discloses a resilient bushing comprising an outer rigid member 11 made of metal, an inner rigid member 13 made of metal, and an elastomeric insert 15 compressively positioned between the outer and inner members 11 and 13. Sievers also discloses that at least one of the inner surface portion 12 of the outer rigid member 11 and the outer surface portion 14 of the inner rigid member 13 is sandblasted to produce a surface roughness height rating of greater than 170 RMS and less than about 260 RMS (measured by SAE standard J448a). (Applicants note that a roughness of 170 RMS corresponds to a roughness of approximately 3.84 μmRz and a roughness of 260 RMS corresponds to a roughness of approximately 5.87 μmRz .) Preferably the roughness height rating of the sandblasted surface is supplemented by forming a phosphate coating on the surface. Sievers fails to teach or suggest a vulcanized and molded rubber elastic body and an organosilane.

The Kurashiki reference discloses a metal/rubber composite damping material comprising a metal fitting 2 composed of an aluminum type metal, an anodic oxidation film 3 formed on the surface of the metal fitting 2 and an organosilane compound film 4 composed of a silane coupling agent and formed on the anodic oxidation film 3. A damping rubber material 1 is bonded to the surface of the organosilane compound film 4 through simultaneous vulcanization type adhesive layers 5 and 6. Corrosion resistance of the metal fitting is obtained by the anodic oxidation film and the organosilane compound film on the surface of the metal fitting. Bonding stability of the adhesive layers with respect to the surface of the metal fitting is obtained by the organosilane compound film. Further, the organosilane compound film is generated by the anodic oxidation film. Kurasaki does not teach or suggest any surface roughness of the metal fitting and the damping rubber material.

The combination of Sievers with Kurashiki does not teach or suggest all of the claim limitations. (See MPEP 2143.03). To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the

- prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). Moreover, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494 (CCPA 1970).

If Sievers and Kurashiki were to be combined, the anodic oxidation film would be formed on the inner surface portion of the outer rigid member of Sievers with the organosilane compound film being formed on the anodic oxidation film, and the inner surface portion having a surface roughness of 170 RMS (3.84 μmRz) to 260 RMS (5.87 μmRz). Amended claim 8 recites a surface roughness of 15 to 50 μmRz . This claimed surface roughness is on the order of 3 to 10 times rougher than the range taught by Sievers (approximately 4 to 6 μmRz). Therefore, the combination of Sievers and Kurashiki fails to teach all of the claim limitations. Furthermore, the surface roughness of Sievers (approximately 4 to 6 μmRz) is designed to facilitate the formation of a phosphate coating of at least 2000 milligrams per square foot. In contrast, Applicants believe that a surface roughness of 4 to 6 μmRz is not suitable for use with organosilane. Therefore, the combination of Sievers and Kurashiki also fails to suggest all of the claim limitations.

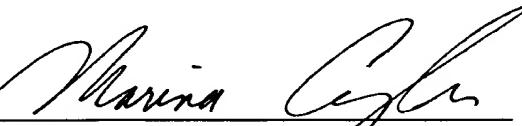
Applicants respectfully submit that the rejection under 35 U.S.C. § 103 is improper, and therefore, the rejection of amended claim 8 should be withdrawn and claim 8 passed to issue. Claim 9 depends from claim 8 and recites additional subject matter. Therefore, for at least the reasons discussed above, the Sievers and the Kurashiki references, either alone or in combination, do not render claim 9 of the present invention obvious. Therefore, rejection of claim 9 under 35 U.S.C. § 103 should be withdrawn and claim 9 passed to issue.

Applicants respectfully request that the Examiner contact the Applicants' representative at the phone number listed below should the Examiner have any questions regarding the present Response.

Appl. No. 09/936,538
Request for RCE dated December 27, 2004
Reply to Final Office Action dated August 25, 2004

Applicants have enclosed a check in the amount of \$910.00, including \$790.00 to cover the fee for the continued examination and \$120.00 to cover the fee for a one-month extension of time. In the event additional fees or charges are due, please charge them to Deposit Account 13-0235.

Respectfully submitted,

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